BLANK
PAGE

Office-Supreme Court, U.S.
FILED
NOV 18 1965
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

October Term, 1965

Docket No. 595

FERNANDA MISANI,

Plaintiff-Appellant,

v.

ORTHO PHARMACEUTICAL CORPORATION, a New Jersey corporation, JOHNSON & JOHNSON, a New Jersey corporation, ROBERT W. JOHNSON, HARRY C. McKENZIE, BERTON J. TODD, EVAN R. SPALT, JOHN FRIEBELY and WILLIAM OROSHNIK,

Defendants-Appellees.

ON APPEAL FROM THE SUPREME COURT OF NEW JERSEY

APPELLANT'S BRIEF IN OPPOSITION TO MOTION TO DISMISS

FERNANDA MISANI,
Plaintiff-Appellant Pro Se,
40 Tamaques Way,
Westfield, New Jersey

Martin Lutz Appellate Printers, Inc.
New York • Philadelphia • Newark • New Brunswick

BLANK
PAGE

INDEX

	Page
Introduction	2
Argument:	
I. Federal Supremacy in the Patent Field	3
II. The Judgment of the Supreme Court of New Jersey does not Rest on an Adequate Non-Federal Ground, but is an Explicit Determination of the Federal Questions and Invalidates Federal Law	4
III. The General Verdict of No Cause of Action is the Result of the Errors in the Court's Charge, as to the Applicable Federal Law.	4
IV. The holding of the Trial Judge, that a Scientist has no Right to have his Name on a Patent, is against Public Policy and invalidates 35 U.S.C. 102(f) and 111	9
V. The Supreme Court of New Jersey has issued the Certificate of Federal Questions. The Questions have been timely raised before the Courts below and are Substantial.	10
Conclusion	17
APPENDIX E:	
Certificate of Federal Questions, issued by the Supreme Court of New Jersey.	1a

Page

Table of Citations

Application of Brown, 329 F.2d 1006, (C.C. P.A. 1964) 15

Brulotte v. Thys, 379 U.S. 29 3

C.F. Mueller Co. v. Zeregas Sons Consol., 12 F.2d 517, (2nd Cir. 1926) 16

Concrete Mixing & Conveying Co. v. R.C. Storrie & Co., 27 F.2d 838 (9th Cir. 1928) 16

E. I. DuPont de Nemours & Co. v. Ladd, 328 F.2d 547 (D.C. Cir. 1964) 15

Ensten v. Simon, Asher & Co., 282 U.S. 445 14

Manson v. Brenner, 333 F.2d 234 (C.C.P.A. 1964); cert. granted 33 U.S.L. Week 3349 13

Marconi Wireless Co. v. United States, 320 U.S. 1 14

Mason v. Hepburn, 13 App. D.C. 86 (D.C. Cir. 1898) 12

Mercoid Corp. v. Mid-Continent Invest. Co., 320 U.S. 661 16

Odiorne v. Amesbury Natl. Factory, 2 Mason 28; 18 Fed. Cases 578 (No. 10, 430) (C.C.D. Mass. 1819) 10

Sears, Roebuck & Co. v. Stiffel Company, 376 U.S. 225 3

Index

	Page
Sperry v. Florida, 373 U.S. 379	3,16
United Carbon Co., Inc., v. Carbon Black Research Foundation, 59 F. Supp. 384 (D. Md. 1945)	14
Walker Process Equipment Inc. v. Food Machinery and Chemical Corp., 335 F.2d 315 (7th Cir. 1964) cert. granted 34 U.S. L. Week 3006	13

U.S. CONSTITUTION CITED

U.S. Constitution, Art. I, Sec. 8, Cl. 8	11

STATUTES CITED:

Revised Statutes, Sec. 4916	14
Revised Statutes, Sec. 4922	14
35 U.S.C. 100(b)	6
35 U.S.C. 101	4
35 U.S.C. 102(c)	12
35 U.S.C. 102(f)	9
35 U.S.C. 111	9
35 U.S.C. 112	4,5,12
35 U.S.C. 115	12

Page

35 U.S.C. 135 10

35 U.S.C. 154 3,4,11

35 U.S.C. 251 6,13,14

35 U.S.C. 253 14

RULES OF THE UNITED STATES PATENT OFFICE CITED:

37 C.F.R. 1.216 (a)(4) 15

37 C.F.R. 1.258 15

SUPREME COURT OF THE UNITED STATES

October Term 1965

Docket No. 595

FERNANDA MISANI,

Plaintiff-Appellant,

v.

ORTHO PHARMACEUTICAL CORPORATION, a New Jersey corporation, JOHNSON & JOHNSON, a New Jersey corporation, ROBERT W. JOHNSON, HARRY C. McKENZIE, BERTON J. TODD, EVAN R. SPALT, JOHN FRIEBELY and WILLIAM OROSHNIK,

Defendants-Appellees.

ON APPEAL FROM THE SUPREME COURT OF NEW JERSEY

APPELLANT'S BRIEF IN OPPOSITION TO MOTION TO DISMISS

INTRODUCTION*

Compelling reasons for denying the motion to dismiss the appeal appear on the face of appellees' brief.**

---

* On November 1, 1965, the appellant was admitted to the New Jersey Bar.

** Appellant's Jurisdictional Statement and appellees' brief are cited herein as "PJ (page)" and "D.Br. (page)" respectively. References to appellant's and appellees' respective appendixes filed in the New Jersey proceedings are cited as "R (page) a" and "D (page) a". The appendixes annexed to the Jurisdictional Statement are cited as Appendix A, B, C and D respectively. The appendix annexed hereto is cited as Appendix E.

ARGUMENT

I. Federal Supremacy in the Patent Field.

In support of their contention that the judgment below should be sustained because it rests on an adequate non-federal basis (D.Br.1), appellees rely on two arguments: 1) that the New Jersey courts have held the contract* valid and enforceable against the plaintiff (D.Br.8), and 2) that the jury returned a general verdict of no cause of action (D.Br.6).

Both arguments are untenable. This Court has held that, in matters involving federal policy, the federal law is supreme and state courts must yield. Sperry v. Florida, 373 U.S. 379. A state may not extend the life of a patent, under the guise of enforcing a contract. Sears, Roebuck & Co. v. Stiffel Company, 376 U.S. 225, 231; Brulotte v. Thys, 379 U.S. 29.

In this case, the federal patent laws invalidate a compulsory contract prepared by the legal staff of Johnson & Johnson, for the benefit of the parent company and some eighty subsidiaries, where the contract extends the monopoly for the employer, beyond the seventeen-year period. 35 U.S.C. 154; Mercoid Corp. v. Mid-Continent Invest. Co., 320 U.S. 661. (PJ 6, 13, 22-28). The judgment of the Supreme Court of New Jersey cannot be sustained, inasmuch as the federal questions involved in this appeal were timely raised and argued before the New Jersey courts. The Certificate of Federal Questions annexed hereto (Appendix E), so states.

---

* The full text of the contract is shown at page 8 of Appellant's Petition for Certiorari, Docket No. 819, Fall Term 1962, nine copies of which have been submitted.

II. The Judgment of the Supreme Court of New Jersey does not Rest on an adequate Non-Federal Ground, but is an Explicit Determination of the Federal Questions, and Invalidates Federal Law.

The Supreme Court of New Jersey, in deciding this case in favor of all the appellees, has 1) assumed that Oroshnik conceived the idea and 2) has held that conception of idea is sufficient to constitute inventorship (Appendix B,5a).

Taking the matters in the reverse order, it is submitted that this is an unconstitutional substitution of a state standard in a field of federal pre-emption. Under federal law, 35 U.S.C. 101, 112 and 154, inventorship of a compound requires three elements: a) conception of idea b) reduction to practice and c) a showing of utility. (Compare appellant's Request to charge the jury at R39a to R41a; Exception to the charge, R75a-8 and Appendix C at 19a).

In conclusion, the Supreme Court of New Jersey has not based its decision on a non-federal ground, but has expressly passed upon the federal question, and decided it in a manner which invalidates federal law.

III. The General Verdict of No Cause of Action is the Result of the Errors in the Court's Charge, as to the Applicable Federal Law.

On the factual issue of "Who conceived the idea?", the Supreme Court of New Jersey has inferred that the jury found in Oroshnik's favor. It summarily said:

> "...in the light of the whole record including the trial court's charge, we believe

> that the jury's verdict may fairly be read as evidencing its finding that there had been no lack of good faith...and that, as between the plaintiff and Oroshnik, the latter rather than the former, conceived the idea for the compound" (Appendix B, 5a).

It is this bare inference, not supported by a single reference to the record, or to the court's charge, which, according to the appellees, constitutes an independent non-federal ground for sustaining the judgment below (D.Br.6,8).

The Appellate Division, however, reversing in favor of appellant, had found substantial errors in the court's charge to the jury. The most flagrant errors are:

1. The judge charged that the Beilstein reference amounted to a prior invention and said:

> "We know she (appellant) was not the first inventor..." (R57a).

The Appellate Division found the instruction erroneous and contrary to 35 U.S.C. 112. The Beilstein reference, (R282a), merely a "type formula", could not constitute an invention. It lacked the reduction to practice and showing of utility (Appendix C, 19a to 20a; 28a, 31a).

The judge also charged that the patent, U. S. P. 2,878,263, was "invalid, no good" (R55a) and appellant could not be deprived of credit for something worthless.

2. The judge charged that the error, the too broad claim of U.S.P. 2,878,263, could not be corrected. He said:

> "...Dr. Misani has repeatedly pressed the idea that Ortho could get a good patent if they changed the wording of the claim; and we have had evidence that they couldn't" (R68a).

On the other hand, the Appellate Division found that, under the new statutory provisions, 35 U.S.C. 100(b), the error could be corrected, and that the judge failed to instruct the jury on the applicable federal law,, with respect to the reissue provisions for correcting errors in a patent. 35 U.S.C. 251. (Appendix C, 20a to 21a and footnote; 27a, 28a).

3. The judge also charged:

> "It does not make any difference whether they (appellees) could, or whether they couldn't (correct the error)...that's none of her business (R68a)...They don't have to correct the patent" (R66a).

4. The judge charged:

An employer may "throw inventions of an employee out of the window" (R66a).

5. The judge said:

> "...As far as that process is concerned, frankly, I don't see anything in it at all ..." (R67a).

The Appellate Division, reversing, found error in the failure "to make such minimal exposition of the applicable law" (Appendix C, 22a to 27a) as to the standards of patentability of a process.

6. Appellant requested the trial judge to submit the following interrogatories to the jury:

   1. Who conceived the idea?

   2. Who reduced the idea to practice?

   3. Who devised the means of reducing the idea to practice?

   4. Have the defendants proved that Oroshnik actually conceived, supervised and directed the project, except for bare fact that the plaintiff, a senior chemist, worked in the department?

   Manifestly, the interrogatories were framed to elicit fact-findings in accordance with federal law in a pre-empted field. The trial judge refused to submit the interrogatories to the jury (R213a; R75a-27). The Appellate Division properly found error in the denial (Appendix C, 31a footnote).

7. The judge did not submit the facts to the jury, but essentially charged that Oroshnik was the inventor, because he was in the rank of supervisor. He said:

   "On that point, this is the law: ..a presumption arises that (he) is the inventor (R62a)...Many people invent things but don't even know how to make them" (R63a).

The judge refused to charge the jury to consider appellant's expertise in the field of the invention, (PJ 32) and Oroshnik's admitted lack of familiarity with the subject matter (R26a-16).

8. The judge never submitted the issue of appellees' good faith or bad faith to the jury. On the contrary, he essentially charged that respondent Oroshnik was in good faith because Kell, a member of the patent staff of Johnson & Johnson, concluded that he was "the legal inventor" (R60a; R64a), and that Kell was in good faith. "That's what he had to deal with" (R77a to R78a).

No instruction was given with respect to the duty of a patent attorney to secure a patent in the name of the real inventor. (Compare appellant's Request to Charge, R43a to R47a).

9. The Appellate Division found error in the burden of proof imposed on the appellant. She could not recover for negligence. She should have proved that Kell "acted maliciously, wilfully and wrongfully" and that Oroshnik and Kell "conspired together" (R69a to R71a; Appendix C at 39a).

On the basis of the substantial errors of law, the Appellate Division concluded that the general jury verdict of no cause of action could very well mean nominal damages (Appendix C, 30a), and remanded for trial because appellant could be entitled to punitive damages (Appendix C at 39a).

IV. The Holding of the Trial Judge, that a Scientist has no Right to have his Name on a Patent, is against Public Policy and Invalidates 35 U.S.C. 102(f) and 111.

The trial judge, at the beginning of trial, ruled against the plaintiff on the matter of ownership and held that she had no cause of action for deprivation of intellectual credit (R99a to R101a; R118a). He said:

> "you prove...not that you merely invented it, but that you own it" (R115a to R116a).

Plaintiff's motion for judgment was denied with the language:

> "The Court: The motion of Dr. Misani for a directed verdict is denied...I doubt seriously whether there is a legal right to be presented to the jury...Such examination of the law as I have made indicates to me that there is no right in the law for a person who has no property rights in an invention, to insist upon his or her name being mentioned" (R199a; pp. 782-785 of transcript).

The Appellate Division, in reversing in favor of appellant, had properly found that the holding of the trial judge invalidates 35 U.S.C. 102(f) and is against public policy. A patent must issue in the name of the inventor (Appendix C at 16a). The Appellate Division also noted the prejudice in the "pervasive undertone in the charge as a whole of lack of merit in the plaintiff's entire claim" (Appendix C at 31a).

V. The Supreme Court of New Jersey has issued the Certificate of Federal Questions. The Questions have been timely raised before the Courts below and are Substantial.

On November 1, 1965, the Supreme Court of New Jersey issued the Certificate of Federal Questions (Appendix E, annexed hereto), acknowledging that the federal questions involved in this appeal have been urged and argued by the appellant. Appellees' contention that the questions were not raised below. (D.Br.1,7), is now moot. Further, the New Jersey courts have expressly passed on the federal questions involved.

The following arguments are set forth in answer to appellees' contentions, question per question.

Question 1: Appellees do not deny that assignment of the two patents, U.S.P. 3,079,397 and U.S.P. 3,166,475, would operate to extend the monopoly beyond the seventeen-year period (PJ 6; PJ 22), nor do they deny that the two patents were issued by the United States Patent Office, because an interference proceeding had been instituted and a conflicting interest between the parties had been established. 35 U.S.C. 135 (PJ 5; PJ 11). The rule against double patenting has been consistently applied, since 1819, Odiorne v. Amesbury Natl. Factory, 2 Mason 28; 18 Fed. Cases 578 (No. 10, 430) (C.C.D. Mass. 1819).

Appellees, however, argue that the two patents were not part of the record (D.Br.7). This argument is untenable. During trial, in 1962, appellant offered in evidence a communication from the United States Patent Office, which showed that the two patents

would issue (R209a; R185a to R189a; R198a; Appendix C at 38a). The trial judge excluded it. The two patents issued after trial, in 1963 and 1965 respectively, that is, during the pendency of the appeal before the Appellate Division and the New Jersey Supreme Court. Appellant immediately brought the issuance of the two patents to the attention of the courts below, and they are referred to in the courts' opinions (Appendix C at 31-32; Appendix B at 5a).

The question of extension of the monopoly, in conflict with 35 U.S.C. 154, has been raised and argued as soon as the patents issued. The courts below have expressly passed on it with the holding "It is frivolous". Appellees will "presumably compel assignment" of the patents (Appendix C at 15a, 32a, Appendix B at 3a).

Question 2: This question, whether an employer may conceal and "scrap" inventions of an employee, and later, secure a patent in the name of one who is not the inventor, (PJ 4, 7, 29, 32-34), is essentially by-passed by the appellees. Their silence is an implied admission that they concealed and suppressed the invention, in 1956, for malicious motives.

The crux of the matter is that Johnson & Johnson has argued before the courts below that an employer may conceal or abandon inventions of an employee, has no duty to determine who is the inventor and is free to take inventions of one employee and include them in a patent in the name of another employee. The present holding of the New Jersey courts that an employer may "scrap inventions of employees at its unfettered will" (Appendix B at 3a; Appendix C at 14a), under the guise of enforcing proprietary rights, under state law, effectively destroys our constitutional policy. U.S. Const., Art. I, Sec. 8,

Cl. 8, and invalidates 35 U.S.C. 102(c). The primary purpose of granting monopolies is to promote the progress of science and useful arts. The inventor himself, or anyone claiming under him, has no right, without just cause or reason, to conceal his invention. Concealment and suppression cause a forfeiture of the right to a patent. Mason v. Hepburn, 13 App. D.C. 86 (D.C. Cir. 1898).

Appellees' motion to dismiss should be denied, to define the scope of federal supremacy and to preserve the constitutional policy of promoting the progress of science and useful arts. The issue is of profound importance in a society where thousands of scientists are employed by large corporations, subject to adhesion-type, "take-it-or-leave-it" contracts.

Question 3: Appellees do not deny that product, process and use in this case constitute a single invention, and concede (D.Br.9) that 35 U.S.C. 112 requires:

> "...a description of the invention, and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains,...to make and use the same and...the best mode contemplated by the inventor of carrying out his invention."

There is no invention until the idea is reduced to practice and utility is shown. Even assuming, arguendo, Oroshnik conceived the idea of making the compound, he could not be the inventor. When he executed the oath that he was the inventor, 35 U.S.C. 115, he knowingly executed a false oath (PJ 28-29).

In direct contrast with appellees' assertion that the issues are not substantial, it should be noted that this Court has recently granted certiorari in Manson v. Brenner, 333 F.2d 234 (C.C.P.A. 1964) cert. granted 33 U.S. Law Week 3349, and in Walker Process Equipment Inc. v. Food Machinery and Chemical Corp., 335 F.2d 315 (7th Cir. 1964) cert. granted 34 U.S. Law Week 3006. These cases involve the identical issues of requirement of utility and fraud on the United States Patent Office in the oath accompanying the application.*

Question 4: is also by-passed (D.Br.9). Appellees do not rebut the facts and the law as presented by the appellant (PJ 11-13; PJ 36).

After U.S.P. 2,878,263 issued, appellant sought an adjudication of inventorship by the United States Patent Office, requested the institution of an interference proceeding and urged that the correction of the too broad claim could be made under the reissue provisions, 35 U.S.C. 251 (R211a; R125a; R198a).

Appellees took advantage of their patentee status and the lack of jurisdiction of the administrative agency over an issued patent. They knew that they would lose in that proceeding and provoked the dissolution of the interference (R210a; R219a). The courts below have ratified Johnson & Johnson's retaining the benefit of the issued patent and refusal to

---

* The cases cited by the appellees at D.Br.9 corroborate appellant's argument. They stand for the rule that claims define the area of the monopoly. The broad claim to the product, in U.S.P.2,878,263, (PJ 15) gave Johnson & Johnson, in 1959, a monopoly for seventeen years, that is, the right of "making, using or selling" the product, by any process and for every use, including the process and use described in the specification. (PJ 23 to 28).

continue the contest to an adjudication of inventorship by the United States Patent Office.

Question 5: is confused with Question 6 (D.Br.9-10).

The nature of a patent, a grant from the government and a monopoly on the public, imposes on a patentee the duty either 1) to correct errors by limiting the broad scope of the claim or claims, 35 U.S.C. 251 or 2) to disclaim the grant. 35 U.S.C. 253 (PJ 12; 36-37). Marconi Wireless Co. v. United States, 320 U.S. 1, 58. This Court in Ensten v. Simon, Asher & Co., 282 U.S. 445, 452, elaborated on the duty of "disavowal of the apparent right to exclude others from something improperly included in the words of the grant".

In conflict with statutory law and the holding of this Court, the courts below have held that an employer may retain a too broad monopoly and has no duty to correct the errors:

> "Ortho owed her no duty...to repair any deficiency in the patent issued, by amendment or otherwise" (Appendix C, at 15a; Appendix B, at 5a).
>
> "This is none of her business" (R66a).

The case cited by the appellees, United Carbon Co., Inc., v. Carbon Black Research Foundation, 59 F. Supp. 384, 387, 388 (D. Md. 1945), is good authority for the rule that the reissue provisions to correct errors, 35 U.S.C. 251 (formerly Rev. St. Sec. 4916) and the disclaimer provisions, 35 U.S.C. 253 (formerly Rev. St. 4922), are usually in the alternative and not coextensive. What the appellees did in the present case is the opposite: they refused to comply, with neither the reissue nor the disclaimer provisions.

Question 6: Appellees primarily contend that appellant has conceded the invalidity of U.S.P. 2,878,263.* The fact is that appellant never conceded the invalidity of the patent. In reliance on Rule of the United States Patent Office, 37 C.F.R. 1.258, she urged that the trial judge exclude any reference to the defect in the patent (R161a to R163a), requested a charge to the jury to the same effect (R38a), and excepted to the Court's charge (R75a-1 to R75a-13). Her testimony was that the defect, rather than invalidity, could be cured at any time during the seventeen-year period (R123a). The doctrine of estoppel should have been applied against appellees for retaining the full monopoly and refusing to correct the error (PJ 36).

It is significant that the broad product claim of U.S.P. 2,878,263 is now fully valid, under prevaling case law. The recent decisions, Application of Brown, 329 F.2d 1006, 1009 (C.C.P.A. 1964) and E.I. DuPont de Nemours & Co. v. Ladd, 328 F.2d 547 (D.C. Cir. 1964) have held that a mere name and a formula in the prior art do not defeat patentability of a product. It is also significant that, as of this date, no court has ordered the appellees to disclaim U.S.P. 2,878,263 and that they still retain the monopoly under this patent.

Question 7 (PJ 8, 35): Appellees concede that application of the rule of the United States Patent Office, 37 C.F.R. 1.216 (a)(4), would have excluded Oroshnik's testimony (D.Br.10) but seek to deny the jurisdiction of this Court by appeal by claiming that the rules

* They state: ..."appellant admitted the invalidity of the patent" (D.Br.4-5)..."the patent was conceded by all to be invalid" (D.Br.7) ..."the issue of patent invalidity was tried with plaintiff's acquiescence" (D.Br.10).

of the United States Patent Office are not binding on state courts. Their contention is in conflict with the holding of this Court, Sperry v. Florida, 373 U.S. 379.

The cases cited by the appellees support appellant's argument, since extrinsic evidence, corroborative of the testimony of each party, was available, "one witness" other than the party, in C.F. Mueller Co. v. Zeregas Sons Consol., 12 F.2d 517, 518 (2nd Cir. 1926) and authentic exhibits in Concrete Mixing & Conveying Co. v. R.C. Storrie & Co., 27 F.2d 838, 840 (9th Cir. 1928).

Question 8: Appellees broadly rely on the doctrine of res judicata, assert that..."the issues were determined favorably to them" and appellant is prevented from relitigating the issues (D.Br.11).

It is submitted that this case is governed by the principle that a prior judgment is res judicata only as to those matters upon the determination of which the finding or verdict was rendered. Mercoid Corp. v. Mid Continent Invest. Co., 320 U.S. 661, 671. The issue determined in the first case was that "the termination of employment was not wrongful ..it being a hiring at will" (Barger, J., first case) at 81a to 82a; 67a; Appendix C at 10a). The contract, now enforced against appellant was not considered in the first case. If the contract of employment was terminable at will and the employer was bound to nothing, the agreement to assign inventions is invalid because totally lacking in mutuality. Further, at the time when appellant urged that the two cases should be consolidated, because of the identical issues on the law and on the facts, appellees opposed consolidation. Application of the doctrine of res judicata rewards appellees for splitting the litigation, and for excluding material evidence in both cases.

CONCLUSION

For the foregoing reasons, it is submitted that this case involves substantial federal questions, that the judgment of the Supreme Court of New Jersey does not rest on an adequate nonfederal ground, and that this Court has jurisdiction, both by appeal and certiorari.

Respectfully submitted,

FERNANDA MISANI
Appellant pro se
40 Tamaques Way
Westfield, New Jersey